REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed February 12, 2003. Upon entry of the amendments in this response, claims 2 – 9 and 19 remain pending. In particular, Applicants have directly amended claims 2 – 5, have added claim 19, and have canceled claims 1 and 10 - 18 without prejudice, waiver, or disclaimer. Applicants have canceled claims 1 and 10 - 18 merely to reduce the number of disputed issues and to facilitate early allowance and issuance of other claims in the present application. Applicants reserve the right to pursue the subject matter of these canceled claims in a continuing application, if Applicants so choose, and do not intend to dedicate the canceled subject matter to the public. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

Rejection Under 35 U.S.C. §101

The Office Action indicates that claims 1 – 18 stand provisionally rejected under 35 U.S.C. U.S.C. §101 as claiming the same invention as that of claims 1 – 15 of copending Application No. 09/715,253 (the "'253 application"). Applicants respectfully traverse this rejection.

In determining whether a statutory basis for a double patenting rejection exists, the question to be asked is: Is the same invention being claimed twice? This is because 35 U.S.C. §101 is to prevent two patents from issuing on the same invention. "Same invention" under 35 U.S.C. §101 means identical subject matter.

One test for determining the existence of double patenting under 35 U.S.C. §101 is whether a claim in the application under examination could be literally infringed without literally infringing a corresponding claim in the other application or patent. If this is possible, then identical subject matter is not defined by both claims and statutory double patenting does

not exist. With respect to this application and the '253 application, an embodiment of a device having an "input mechanism [having] a first compositing element and a second compositing element" would infringe the "input mechanism" element of amended claim 2, but would not infringe the claims of the '253 application. Moreover, the claims of this application do not meet the limitation of mathematically combining an offset to coordinate values, which is generally recited in independent claim 1 of the '253 application. For at least the foregoing reasons, Applicants respectfully assert that the rejection under 35 U.S.C. §101 is improper and should be removed.

Rejections 35 U.S.C. §102 (a)

The Office Action indicates that claims 1 - 15 stand rejected under 35 U.S.C. §102(a) as being clearly anticipated by *MacInnis*. As set forth in detail below, Applicants respectfully assert that the rejection is improper.

> 2. (Currently Amended) A device for producing a composite digital video data stream containing pixel data corresponding to an image to be rendered, the composite digital video data stream being formed from multiple digital video data streams, each of the multiple digital video data streams being provided by a graphics pipeline, each graphics pipeline being configured to process pixel data corresponding to at least a portion of the image to be rendered, said device comprising:
>
> an input mechanism configured to receive the multiple digital video data streams from the graphics pipelines, provide a frame of data corresponding to the image to be rendered, and insert pixel data from the multiple digital video data streams into said frame of data such that, in response to receiving a first of the multiple digital video data streams, said input mechanism provides said frame of data and inserts the pixel data from the first of the multiple digital video data streams into a corresponding portion of said frame of data to form at least a portion of the composite digital video data stream;
>
> ***wherein said input mechanism has a first compositing element and a second compositing element***, said first compositing element being configured to provide said frame of data corresponding to the image to be rendered in response to receiving pixel data corresponding to the first of the multiple digital video data streams, said first compositing element being further configured to insert the pixel data corresponding to the first of the multiple

digital video data streams into said corresponding portion of said frame of data to form a first compositing digital video data stream, said second compositing element being configured to receive pixel data corresponding to the second of the multiple digital video data streams and said first compositing digital video data stream, said second compositing element being further configured to combine the pixel data corresponding to the second of the multiple digital video data streams and said first compositing digital video data stream to form a second compositing digital video data stream.
(Emphasis Added).

Applicants respectfully assert that *MacInnis* is legally deficient for the purpose of anticipating claim 2 because *MacInnis* does not teach or otherwise disclose at least the features emphasized above in claim 2. In this regard, the Office Action indicates that *MacInnis* teaches the limitations of claim 2 by referring Applicants to FIG. 4 and the accompanying description at column 8, lines 61 – 63. After thoroughly reviewing the reference, Applicants respectfully disagree with the contention that *MacInnis* teaches at least a first compositing element and a second compositing element. In particular, *MacInnis* teaches a video compositor block 108 that "blends the output of the graphics display pipeline, the video display pipeline, and passthrough video." *MacInnis*, column 8, lines 61 – 63. Note that the video compositor block 108 is a single block in FIG. 4 and the accompanying description of that block does not teach or otherwise disclose a first compositing element and a second compositing element, much less the configurations of the respective elements that are further defined in claim 2. Therefore, Applicants respectfully assert that the rejection is improper and that claim 2 is in condition for allowance.

Since claims 3 – 9 are dependent claims that include all of the features/limitations of claim 2, Applicants respectfully assert that these claims are also in condition for allowance. Additionally, each of these dependent claims recite other features that also may serve as an independent basis for patentability.

Rejections 35 U.S.C. §102 (e)

The Office Action indicates that claims 1 – 18 are provisionally rejected under 35 U.S.C. § 102(e) as being anticipated by the '253 application. Specifically, the Office Action indicates that based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. § 102(e), if patented. Applicants respectfully traverse this rejection.

Applicants respectfully assert that the filing date of the '253 application is the same as the filing date of the present application. Therefore, Applicants respectfully assert that the provisions of 35 U.S.C. 102(e) are inapplicable, and that the rejection should be removed.

35 U.S.C. §102 (f)

The Office Action indicates that claims 1 – 18 stand "possibly" rejected under 35 U.S.C. § 102(f). As best understood by Applicants, the Office Action has not formally rejected the claims under 35 U.S.C. § 102(f), as claims 1 – 18 are "possibly" rejected. If the intention is to formally reject claims 1 – 18 under 35 U.S.C. § 102(f), Applicants respectfully request an appropriate period of time in which to respond to another non-final Office Action that properly indicates the rejection.

Rejections 35 U.S.C. §102 (g)

The Office Action indicates that the U.S.P.T.O. will not normally institute an interference between applications or a patent in an application of common ownership, but that the Assignee is required to state which entity is the prior inventor of the conflicting subject matter. In light of the above remarks, the above requirement has been rendered moot.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the pending claims 2 – 9 and 19 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, Washington D.C. 20231, on 5/7/03.

Stephanie Riley
Signature